REMARKS

Reconsideration and withdrawal of all grounds of rejection, and allowance of the pending claims are respectfully requested in light of the amendments and remarks made herein.

Claims 1-3, 10-14 and 17 stand objected to because of informalities. In response, claim 1-3, 10-14 and 17 have been amended as suggested by the Examiner. Accordingly, applicants request removal of these objections.

Applicants greatly appreciate the Examiner's indication that claims 1-3, 10-14 and 17 are allowable.

Claim 6 stands rejected under 35 USC 103(a) as being unpatentable by Yamamoto (U.S. Patent No. 6,831,705 B2) in view of Izumiyama et al. (U.S. Patent No. 6,141,561). Applicants respectfully traverse this rejection.

As indicated in the Office Action, Yamamoto fails to disclose measuring a signal quality for determination of operation of an amplifier (on/off) comprises determining whether a DC voltage level of an automatic gain control signal has a first value indicating that the automatic gain control is inactive or has a value within a predetermined range indicating that the automatic gain control system is active. The addition of Izumiyama fails to cure the infirmities of Yamamoto.

The Office Action indicates that the above limitations at disclosed in Izumiyama in col. 3, lines 44-53; col. 2, lines 45-48. Applicants respectfully disagree.

In col. 3, lines 44-53 Izumiyama teaches a reception circuit for a cellular telephone that has an intermediate frequency amplifier circuit in the processing circuit, and when AGC voltage for controlling a gain of the intermediate frequency amplifier circuit is not higher than the predetermined voltage, induces the received signal to the processing circuit through the amplifier circuit at the forefront stage while when the AGC voltage exceeds the predetermined voltage, the received signal is induced to the processing circuit through the bypass circuit.

Thus, Izumiyama only teaches controlling the gain on an amplifier which induces the use of either the forefront stage or a bypass circuit. Applicants can find nothing therein that teaches "measuring a signal quality for determination of operation of an amplifier (on/off) comprises determining whether a DC voltage level of an automatic gain control signal has a first value indicating that the automatic gain control is inactive or has a value within a predetermined range indicating that the automatic gain control system is active" as recited in the Office Action.

The Office Action further interprets the intermediate frequency amplifier of Izumiyama as the interface amplifier 16 of Yamamoto, and the forefront stage amplifier of Izumiyama as the high gain amplifier 31 of Yamamoto, and this in turn teaches measurement of the gain control (AGC) voltage of the IF amplifier and when the AGC

voltage of the IF amplifier has a first value under the predetermined voltage level, the signal would pass through the front stage amplifier (on stage on the front stage amplifier) (similar to high gain RF amplifier 31 of Yamamoto); and when the AGC voltage level has a value within a predetermined range (above the predetermined value), then the front stage amplifier would be bypass (off stage on the front stage amplifier). Applicants respectfully disagree.

Izumiyama teaches the use of one intermediate frequency amplifier and the Office Action indicates that this one amplifier is the same as two different amplifiers in Yamamoto. And it is not seen how the above teaches measuring a signal quality for determination of operation of an amplifier (on/off) comprises determining whether a DC voltage level of an automatic gain control signal has a first value indicating that the automatic gain control is inactive or has a value within a predetermined range indicating that the automatic gain control system is active, as claimed in claim 6. Where is the suggestion found in either of Yamamoto and Izumiyama? If the suggestion is not there, why would someone of ordinary skill in the art decide to modify the combination of Yamamoto and Izumiyama?

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicants respectfully submit that the Examiner has used impermissible hindsight to reject claim 6 35 U.S.C. § 103(a). The Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find many elements of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references and further a motivation to modify the combination to justify a finding of obviousness. Applicants respectfully submit that the Examiner has not met this burden by simply stating "It is desirable to measure a signal quality for determination of operation of an amplifier…"

The mere fact that the prior art device could be modified so as to produce the claimed device, which in this case even in combination it does not (as discussed herein), is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900, 902 (Fed, Cir. 1984); and In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making the modification appears to come from the present patent application itself.

How can the Office Action espouse that the modification forwarded does not include knowledge gleamed only from the Applicants' disclosure? If this reconstruction did not come from the present application, where did it come from? The reconstruction

and modification certainly did not come from the prior art. Even the Office Action does not point to any portions of the prior art for teaching the suggestion of reconstructions/modification as pointed out above.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

The Office Action further indicates that Izumiyama also discloses in column 2, lines 45-48, that when the AGC voltage have the maximum gain, the intermediate amplifier is on it activated stage; therefore, when the AGC voltage value of the intermediate amplifier is above the predetermined level, the intermediate amplifier is active. With respect to the limitation that the AGC control voltage is a DC voltage, Izumiyama discloses an invention that is implemented on a mobile station, therefore the AGC control voltage has to be in direct current (DC). Applicants respectfully disagree.

Izumiyama teaches in the entire paragraph noted above, column 2, lines 38-54:

> If, however, a specified cellular telephone is used in a distant area from a base station, the reception level of a transmitted signal (hereinafter, referred to as a desired signal) from the base station becomes low, and therefore, AGC voltage, at which these intermediate frequency amplifier circuits **48** and **49** have the maximum gain, is supplied to these intermediate frequency amplifier circuits **48** and **49**, resulting in that the intermediate frequency amplifier circuits **48** and **49** enter an activated state with the maximum gain. If, in such a state, there exists another cellular telephone transmitting to and receiving from the base station in a near district, this cellular telephone is transmitting a high-level signal (hereinafter, referred to as non-desired signal) and therefore, a high-level non-desired signal from another cellular telephone will be inputted to the reception circuit **44** through the antenna **43** of the specified cellular telephone.

Thus, Izumiyama only teaches that when the amplifier has the maximum gain…the amplifier enters **an** activated state with the maximum gain. In other words the amplifier can have many activated states with various gain levels, and the maximum gain is only one of such activated states. Accordingly, Izumiyama fails to teach the above noted limitations of claim 6.

It is accordingly respectfully submitted that the device of claim 6 is not anticipated or made obvious by the teachings of Yamamoto in view of Izumiyama.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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